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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/561,286	12/20/2005	Ulrich Bohne	3556	2811

7590
Striker Striker & Stenby
103 East Neck Road
Huntington, NY 11743

12/28/2009

EXAMINER

GRANT, ALVIN J

ART UNIT	PAPER NUMBER
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3723

MAIL DATE	DELIVERY MODE
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12/28/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,286	Applicant(s) BOHNE ET AL.	
	Examiner ALVIN J. GRANT	Art Unit 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 19-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-16, 19 and 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over Durr 5,644,846 in view of Pedrini 6,273,799.

Regarding claims 1-16, 19 and 20, Durr discloses a reciprocating stroke drive mechanism comprising claimed elements that include: an eccentric transmission, having an imbalance compensation element (13); an eccentric element (at 9); an armature shaft (11); and a drive shaft (5), wherein the eccentric element is rotatably and fixedly mounted on the armature shaft and rotates with the armature shaft and converts, due to its own rotation during an operation mode, a revolving rotary motion of the armature shaft in an oscillating rotary motion of the drive shaft (5) in order to drive an insertion tool (2) of a hand-held power tool (Fig. 1) to oscillate, wherein the imbalance compensation element (13) is integral to another functional unit (20); the motor is inherently electric; and the eccentric element and the armature shaft rotate about the same axis. Durr does not specifically disclose the armature recess receiving the armature shaft or the imbalance compensation element being a one-piece part of another functional element. However Durr's apparatus contains elements that are equivalent to

Art Unit: 3723

those claimed. Therefore configuring Durr's elements to obtain predicted results may be obtained through routine experimentation. Furthermore, making the imbalance compensation element as a one-piece part of another element is a matter of obvious design choice since forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. It is noted that Durr discloses an oscillating mode of operation but does not specifically an oscillating link. Pedrini discloses a polishing apparatus having an oscillating link so as to manipulate the output shaft. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have made Durr's apparatus to have an oscillating link as taught by Pedrini so as to manipulate the output shaft.

Regarding claims 21-27, Durr does not specifically disclose the use of ball bearings. Pedrini discloses the use ball bearings so as to minimize the occurrence of frictional forces on the shaft. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used ball bearings in the modified Durr's apparatus as taught by Pedrini so as to minimize the occurrence of frictional forces on the shaft.

Response to Arguments

3. Applicant's arguments with respect to claims 1-16, 19 and 20-27 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN J. GRANT whose telephone number is (571)272-4484. The examiner can normally be reached on Mon-Fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph J. Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3723

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. J. G./
Examiner, Art Unit 3723

/Joseph J. Hail, III/
Supervisory Patent Examiner, Art Unit 3723